



[10191/1773]

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

----- X
In re Application of:

Thomas MUELLER et al.

For: DEVICE FOR PLAYING BACK
MULTIMEDIA DATA FILES FROM
A STORAGE DEVICE IN AN
AUTOMOTIVE SOUND SYSTEM

: Examiner: Xu Mei

Filed: March 23, 2001

: Art Unit: 2615

Serial No.: 09/816,526

I hereby certify that this correspondence is being deposited with the
United States Postal Service with sufficient postage as first class mail
in an envelope addressed to:

Mail Stop APPEAL BRIEF - PATENTS
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Date: 6/7/2010

Signature: [Signature]

AARON C. DEDITCH
(33.865)

**SUPPLEMENTAL/REPLACEMENT APPEAL BRIEF
PURSUANT TO 37 C.F.R. § 41.37**

SIR:

In response to the Notification of Non-Compliant Appeal Brief mailed on
May 6, 2010 (the one-month response date for which is June 7, 2010 (since June 6, 2010 is a
Sunday)), Applicants submit herewith a Supplemental/Replacement Appeal Brief.

An Appeal Brief was filed on September 27, 2007. An Examiner's Answer was
mailed on January 2, 2008 and Applicants filed a Reply Brief on February 28, 2009. The
Reply Brief was received and entered according to the Office communication mailed on
April 23, 2008. A Notification of Non-Compliant Appeal Brief was mailed on May 6, 2010,
so that the one-month response date is June 7, 2010 (because June 6, 2010 is a Sunday).

U.S. Pat. App. Ser. No. 09/816,526
Attorney Docket No. 10191/1773
Supplemental/Replacement Appeal Brief

In the above-identified patent application (“the present application”), Appellants mailed a Notice Of Appeal on March 23, 2007 – which was filed in the Office on March 27, 2007 --- from the Final Office Action issued by the U.S. Patent and Trademark Office on November 29, 2006. In the Final Office Action, claims 2 to 17 were finally rejected.

A Response After A Final Office Action was mailed on January 24, 2007, and an Advisory Action was mailed on March 8, 2007.

It is understood for purposes of the appeal that any Amendments to date have already been entered by the Examiner, and that the Response After Final does not require entry since it included no amendments.

The previously filed Appeal Brief filed on September 27, 2007 in support of the appeal of the final rejections of claims 2 to 17 was deemed non-compliant in the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) of May 6, 2010. In the Notification it was stated as to item 4 that “The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal” because the brief assertedly does not separately map independent claims 2, 5, 9 and 17 to the specification as filed by line and page number, as stated in item 10.

The Supplemental/Replacement Appeal Brief is believed to comply with all the requirements of Rule 41.37, and to address the issues raised in Notice.

The Appeal Brief is believed to comply with all the requirements of Rule 41.37. It is noted that the “concise explanation” language of the Rule is like the “concise explanation” requirement of former Rule 37 CFR 1.192, and that the length of the concise explanation provided herein should therefore be acceptable, since the format was acceptable under 37 CFR 1.192 and since it specifically defines the subject matter of the relevant claims involved in the appeal. AARON C. DEDITCH (reg. no. 33,865) has filed many appeal briefs, the concise explanation for which has ultimately always been accepted by the Patent Office.

U.S. Pat. App. Ser. No. 09/816,526
Attorney Docket No. 10191/1773
Supplemental/Replacement Appeal Brief

The Office is encouraged to contact the undersigned if there are any questions as to the description of the claimed subject matter.

It is noted that the Patent Office Rules do not require the Applicants to include references cited by and relied upon by the Examiner in the Evidence Appendix (although it is required by the Office for the Examiner). In the present Appeal, the Applicants have not submitted any evidence on which they intend to rely, so that the Evidence Appendix lists no evidence.

It is respectfully submitted that the application is in condition for a decision on Appeal and that the final rejections of pending and considered claims 2 to 17 should be reversed for the reasons set forth below.

U.S. Pat. App. Ser. No. 09/816,526
Attorney Docket No. 10191/1773
Supplemental/Replacement Appeal Brief

1. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Robert Bosch GmbH (“Robert Bosch”) of Stuttgart in the Federal Republic of Germany. Robert Bosch is the assignee of the entire right, title and interest in the present application.

2. RELATED APPEALS AND INTERFERENCES

There are no interferences or other appeals related to the present application, which “will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal”.

3. STATUS OF CLAIMS

CLAIM 1 IS CANCELED.

1. Claims 2 to 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,292,440 to Lee (“Lee”) in view of U.S. Patent No. 6,990,208 to Lau et al. (“Lau”).

Appellants therefore appeal from the final rejections of pending claims 2 to 17. A copy of all of the pending claims is attached hereto in the Appendix.

4. STATUS OF AMENDMENTS

In response to the Final Office Action mailed on November 29, 2006, a Response After A Final Office Action was mailed on January 24, 2007 in response to the Final Office Action, and an Advisory Action was mailed on March 8, 2007.

It is understood for purposes of the appeal that any Amendments to date have already been entered by the Examiner, and that the Response After Final does not require entry since it included no amendments.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is described as follows, and is directed to addressing the following problems and/or providing the following benefits, and as described in the context of the present application.

Each of independent claims 2, 5, 9 and 17 include the feature of a processor for decoding the multimedia data files, in which the processor includes an element for displaying directories located in the storage device, and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus.

In particular, this is as follows:

*As to **claim 2**, it is to a device for playing back multimedia data files stored in an automotive sound system, including a display; a loudspeaker for performing a playback of the multimedia data files; an input apparatus; a storage device; and a processor for decoding the multimedia data files, in which the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus.*

In this regard, Figure 1 shows a block diagram of the device for playing back multimedia data files from a storage device in an automotive sound system. The individual components of the device are interconnected via a bus 2. A processor 1, signal processing elements 3, 5 and 7, and the storage device with a disk drive 9 are connected to bus 2 via data inputs/outputs. A display 4 is connected to signal processing element 3. A loudspeaker 6 is connected to signal processing element 5 via a data output. An input apparatus 8 is connected to a data input of signal processing element 7. (See specification, page 5, lines 3 to 18). Processor 1 receives signals from input apparatus 8, and depending on these input signals,

processor 1 performs an action, e.g. the decoding of audio data files or multimedia data files located in storage device 9. If a storage device is inserted into disk drive 9, then processor 1 reads the directory structure of the CD ROM and displays it on display 4. (See specification, page 6, lines 10 to 16).

Figure 2 shows such a directory structure as a directory tree. Located in a main plane 10 are directories 14 and a group of audio data files 13. In a plane 11 below main plane 10, audio data files 13 adjoin the first two directories. A group of audio data files 13 and two further directories 14 adjoin the third directory. A group 13 of audio data files in plane 11 adjoin the last directory of main plane 10. The two directories in plane 11 lead below it to plane 12, a group of audio data files 13 following the two respective directories 14. (See specification, page 6, lines 16 to 26).

Input apparatus 8 has a rocker which is operable in the horizontal and vertical directions, where the horizontal actuation of the rocker leads to a selection from among the individual directories (thus, from among the individual CDs and therefore from among the individual data carriers). Directories 14 are thus interpreted as data carriers. The audio data files are interpreted as individual titles. If at this point, the rocker is used to select a CD (e.g., CD 2) as the second directory, the user stops actuating the rocker when CD 2 appears on display 4. With the vertical operation of the rocker, the user can select the individual titles from CD 2 (e.g., titles 1 through 10). (See specification, page 6, line 28 to page 7, line 3).

If directories (and therefore data carriers) are present in different planes (here, main plane 10 and plane 11) then the directories as data carriers are numbered consecutively CD 1 through CD 6 by processor 1, and are selectable using the horizontal movement of the rocker, that is to say, the actual tree structure plays no role for the utilization; the user only selects from among the data carriers. In this context, the data carriers can either be numbered consecutively according to the planes, or the directories in the subsequent planes can be integrated directly. (See specification, page 7, lines 9 to 15).

*As to **claim 2** (and claim 17), it also includes the feature in which the processor, together with the operation of the input apparatus, is capable of linking the multimedia data files, located on the storage device, to at least one new directory, and the processor provides an option to store the multimedia data files once again.* In this regard, the specification

discloses that the device of the presently claimed subject matter may create so-called play lists. The user uses input apparatus 8 to select audio data files (which are stored in the storage device) and links these audio data files to a new directory, (the device generating a name (e.g., play list 1) to consecutively number the play lists). Using further inputs, the user can sort the audio data files (automatically or manually) according to various criteria. Audio data files can be deleted from the new directory by further inputs. (See specification, page 8, lines 22 to 28).

*As to **claim 5**, it is to a device for playing back multimedia files stored in an automotive sound system, including a display; a loudspeaker for performing a playback of the multimedia data files; an input apparatus; a storage device; and a processor for decoding the multimedia data files, in which the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus. (See specification, page 5, lines 3 to 18; page 6, lines 10 to 26; page 6, line 28 to page 7, line 3; and page 7, lines 9 to 15 as explained more fully above in regard to claim 2).*

*As to **claim 5**, it also includes the feature in which in which after one of the different virtual data carriers is selected, the processor displays the selected one of the different virtual data carriers on the display for a first predefined time, after the first predefined time, the processor displays a first one of the different titles of the selected one of the different virtual data carriers on the display, and the processor, in accordance with an operation of the loudspeaker, plays back the multimedia data file corresponding to the first one of the different titles. In this regard, the specification discloses that if a user inserts a storage device into disk drive 9, then the first title of the first data carrier (in this case, CD 1 which is the first directory) is displayed on display 4, and after a predefined time, the audio data file belonging to this title is played back. All subsequent titles may then be directly played back, so that the driver is free from any operating process. This may be done to the extent that all*

data carriers with all titles are subsequently played through, until the user undertakes an input process using input apparatus 8. (See specification, page 7, line 30 to page 8, line 3).

*As to **claim 9**, it is to a device for playing back multimedia data files stored in an automotive sound system, including a display; a loudspeaker for performing a playback of the multimedia data files; an input apparatus; a storage device; and a processor for decoding the multimedia data files, in which the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus. (See specification, page 5, lines 3 to 18; page 6, lines 10 to 26; page 6, line 28 to page 7, line 3; and page 7, lines 9 to 15 as explained more fully above in regard to claim 2).*

*As to **claim 9**, it also includes the feature in which the processor extracts information from respective ones of the multimedia data files, the processor provides the extracted information to the display; when a respective one of the multimedia data files does not store a corresponding one of the different titles, the processor displays one of a name of the respective one of the multimedia data file and a number as a title on the display. Processor 1 interprets directories 14 as different data carriers. The individual directories are interpreted as CD 1, CD 2, CD 3, etc. The groups of audio data files 13 are represented as titles for the corresponding directory. In this context, processor 1 evaluates the title of the respective audio data file, and displays it on display 4, or if the title is not available, processor 1 displays the name of the audio data file or a number (a track number) on display 4. (See specification, page 6, lines 6 to 16).*

*As to **claim 17**, it is to a device for playing back multimedia data files stored in an automotive sound system, including a display; a loudspeaker for performing a playback of the multimedia data files; an input apparatus; a storage device; and a processor for decoding the multimedia data files, in which the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are*

contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus. (See specification, page 5, lines 3 to 18; page 6, lines 10 to 26; page 6, line 28 to page 7, line 3; and page 7, lines 9 to 15, as explained above as to claim 2).

In this regard, the specification discloses that the device of the presently claimed subject matter may create so-called play lists. The user uses input apparatus 8 to select audio data files (which are stored in the storage device) and links these audio data files to a new directory, (the device generating a name (e.g., play list 1) to consecutively number the play lists). Using further inputs, the user can sort the audio data files (automatically or manually) according to various criteria. Audio data files can be deleted from the new directory by further inputs. (See specification, page 8, lines 22 to 28).

*In summary, the presently claimed subject matter is to a device for playing back multimedia data files stored in an automotive sound system, including a display; a loudspeaker for performing a playback of the multimedia data files; an input apparatus; a storage device; and a processor for decoding the multimedia data files, in which the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus; and in which the processor, together with the operation of the input apparatus, is capable of linking the multimedia data files, located on the storage device, to at least one new directory, and the processor provides an option to store the multimedia data files once again. (see **claim 2**).*

In summary, the presently claimed subject matter is also to a device for playing back multimedia files stored in an automotive sound system, including a display; a loudspeaker for performing a playback of the multimedia data files; an input apparatus; a storage device;

and a processor for decoding the multimedia data files, in which the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus; in which after one of the different virtual data carriers is selected, the processor displays the selected one of the different virtual data carriers on the display for a first predefined time, after the first predefined time, the processor displays a first one of the different titles of the selected one of the different virtual data carriers on the display, and the processor, in accordance with an operation of the loudspeaker, plays back the multimedia data file corresponding to the first one of the different titles. (see claim 5).

In summary, the presently claimed subject matter is also to a device for playing back multimedia data files stored in an automotive sound system, including a display; a loudspeaker for performing a playback of the multimedia data files; an input apparatus; a storage device; and a processor for decoding the multimedia data files, in which the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus; in which the processor extracts information from respective ones of the multimedia data files, the processor provides the extracted information to the display; when a respective one of the multimedia data files does not store a corresponding one of the different titles, the processor displays one of a name of the respective one of the multimedia data file and a number as a title on the display. (see claim 9).

In summary, the presently claimed subject matter is also to a device for playing back multimedia data files stored in an automotive sound system, including a display; a loudspeaker for performing a playback of the multimedia data files; an input apparatus; a storage device; and a processor for decoding the multimedia data files, in which the

processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus. (see claim 17).

Finally, the appealed claims include no means-plus-function language and no step-plus-function claims, so that 41.37(v) is satisfied as to its specific requirements for such claims, since none are present here. Also, the present application does not contain any step-plus-function claims because the method claims in the present application are not "step plus function" claims because they do not recite "a step for", as required by the Federal Circuit and as stated in Section 2181 of the MPEP.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 2 to 17 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,292,440 to Lee ("Lee") in view of U.S. Patent No. 6,990,208 to Lau et al. ("Lau").

7. ARGUMENT

A. The 35 U.S.C. § 103(a) Rejections Of Claims 2 to 17

Claims 4, 5, 6 to 8, 9 and 10 to 17

Claims 2 to 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,292,440 to Lee ("Lee") in view of U.S. Patent No. 6,990,208 to Lau et al. ("Lau").

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine

reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Claim 17 (and claims 2, 5 and 9) relates to a device for playing back multimedia files stored in an automotive environment, which includes a storage device and a processor for decoding the multimedia files. Claim 17 (and claims 2, 5 and 9) provides that the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different *virtual data carriers*, and the multimedia data files as different titles on the display, and the different *data virtual carriers* and the different titles are selectable in accordance with an operation of the input apparatus.

It is respectfully submitted that Lee and Lau, whether taken alone or combined, do not disclose, or even suggest, the feature of displaying directories as different *virtual data carriers*, which are selectable in accordance with an operation of an input apparatus, as provided for in the context of claim 17. Indeed, neither Lee nor Lau disclose nor suggest virtual data carriers as provided for in the context of claim 17. Instead, Lee merely refers to the features of a basic MP3 audio system, and Lau merely refers to directories with more than one playlist, but their playlist is not in any way disclosed as a virtual data carrier.

More specifically, Lee refers to a vehicle-based MP3 player, which “conventionally” displays titles or track numbers of the currently played music, and Lau refers to the downloading of music files to a vehicle sound system, in which play lists are employed for organizing the downloaded music files. As in Figs. 14 and 15 of the Lau reference, such play lists are physically created as part of the storage medium, and according to col. 6, lines 17 to 35, of the Lau reference, the hard disk drive exhibits these physically-created play lists in actual directories that exist on the storage medium, (i.e., a directory for the play lists and a directory for the MP3 files, in which the play lists contain the lists of MP3 files and links are provided between the playlists and MP3 files). Thus, Lau displays the “real” directory structure of playlists that actually exist as such on the storage medium.

In contrast, the presently claimed subject matter provides for the display of virtual data carriers which do not exist as such, but which are provided as part of the display so that a user can more easily search MP3 files in a format he or she may be more familiar with since the user may have previous operating CD changers.

Moreover, one skilled in the art would not identify a playlist as a virtual data carrier, which, as exemplified in the present application, can include a CD, DVD or hard disk. Hence, the systems of Lee and Lau, whether taken alone or combined, do not disclose nor suggest all of the features and advantages of the presently claimed subject matter, with respect to a user exploiting his or her knowledge about navigating CDs and/or CD changers. In this regard, the present application states, for example, on page 1, line 22 to page 2, line 1, that:

It is particularly advantageous that existing data structures are translated into an operating philosophy modeled on a CD changer. In this context, virtual data carriers are assigned to the individual directories in which the multimedia data files are located, for example, CD 1 is assigned to directory 1, and the titles or numbers of the multimedia data files are assigned to the multimedia files contained therein. This results in markedly simplified operation which is very useful, particularly for an automobile driver, since he or she is not distracted by a complicated operation.

Accordingly, for at least these reasons, it is respectfully submitted that claim 17 is allowable, as are its dependent claims 4, 6, 8 10 to 16.

Claims 2 (and its dependent claim 3), 5, and 9 include features like those of claim 17 and are therefore allowable for essentially the same reasons as claim 17.

Claims 2 and 3

As further regards the rejections of claims 2 and 3, it is respectfully submitted that Lee and Lau, whether taken alone or combined, do not disclose or even suggest a processor that, together with an operation of an input apparatus, is capable of linking multimedia data files, located on a storage device, to at least one new directory, and that provides an option to store the multimedia data files once again, as provided for in the context of claim 2, as presented. Indeed, the MP3 files referred to by Lee and/or Lau cannot be arranged in a new directory by the user.

Accordingly, claim 2 and its dependent claim 3 are allowable for these further reasons.

As to the meaning of the “virtual data carrier” feature as recited in the context of the present claimed subject matter of the claimed subject matter, it is axiomatic that the terms of a claim are not interpreted in a vacuum, even though a pending claim may be “given the broadest reasonable interpretation consistent with the specification.” M.P.E.P. § 2111. The law supports the eminently reasonable interpretation of the terms discussed herein based on the specification, as explained above. (See In re Weiss, 26 U.S.P.Q.2d 1885, 1887 (Fed. Cir. 1993) (when interpreting a claim term or phrase, one must “look to the specification for the meaning ascribed to that term”; Board reversed) (unpublished decision); In re Okuzawa, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976) (“claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation”; Board reversed; emphasis in original) (citing In re Royka, 180 U.S.P.Q. 580, 582-83 (C.C.P.A. 1974) (claims are “not to be read in a vacuum and while it is true that they are to be given the broadest reasonable interpretation during prosecution, their

terms still have to be given the meaning called for by the specification of which they form a part”; Board reversed; emphasis in original); and In re Rohrbacher, 128 U.S.P.Q. 117, 119 (C.C.P.A. 1960) (an “applicant is his own lexicographer and words used in his claims are to be interpreted in the sense in which they are used in the specification”; Board reversed)).

This applies to the “virtual data carrier” carrier features of each of the independent claims, as provided for in the context of the claimed subject matter and as disclosed as to the only embodiments of the specification and drawing, as explained herein and in the present application.

Accordingly, it is respectfully submitted that claims 2, 5 and 17 are allowable for the foregoing reasons, as are their respective dependent claims.

As further regards all of the obviousness rejections discussed herein, in rejecting a claim under 35 U.S.C. § 103(a), the *Office* bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Thus, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also suggest combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Moreover, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” (See Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998)). It is respectfully submitted that, as discussed above, the references relied on,

whether taken alone or combined, do not suggest in any way modifying or combining the references so as to provide the presently claimed subject matter for addressing the problems and/or providing the benefits of the “virtual data carrier” feature of the claimed subject matter as explained herein and in the specification.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, it is believed that there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference relied upon makes plain that it simply does not describe the features discussed above of the claims as now presented.

Thus, the proper evidence of obviousness must show why there is a suggestion as to the reference so as to provide the subject matter of the claimed subject matter and its benefits.

In short, there is no evidence that the reference relied upon, whether taken alone or otherwise, would provide the features of the claims discussed above. It is therefore respectfully submitted that the claims are allowable for these reasons.

As further regards all of the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See *In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and this Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))).

In short, the Office bears the initial burden of presenting a proper prima facie unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

U.S. Pat. App. Ser. No. 09/816,526
Attorney Docket No. 10191/1773
Supplemental/Replacement Appeal Brief

In short, claims 2 to 17 are allowable for all of the above reasons.

CONCLUSION

In view of the above, it is respectfully requested that the rejections of claims 2 to 17 be reversed, and that these claims be allowed as presented.

Dated: _____

6/7/2010

Respectfully submitted,

By: _____

Gerard A. Messina
(Reg. No. 33,865)

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

1959602

[10191/981A]

CLAIMS APPENDIX

1. (Canceled)
2. (Previously Presented) A device for playing back multimedia data files stored in an automotive sound system, comprising:
 - a display;
 - a loudspeaker for performing a playback of the multimedia data files;
 - an input apparatus;
 - a storage device; and
 - a processor for decoding the multimedia data files, wherein:
 - the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus; and
 - wherein:
 - the processor, together with the operation of the input apparatus, is capable of linking the multimedia data files, located on the storage device, to at least one new directory, and
 - the processor provides an option to store the multimedia data files once again.
3. (Previously Presented) The device according to claim 2, wherein:
 - the input apparatus includes a plurality of operating control elements that permits a management of the at least one new directory.
4. (Previously Presented) The device according to claim 17, wherein:
 - the input apparatus includes a rocker that is operable both in a vertical direction and in a horizontal direction.

5. (Previously Presented) A device for playing back multimedia files stored in an automotive sound system, comprising:

a display;

a loudspeaker for performing a playback of the multimedia data files;

an input apparatus;

a storage device; and

a processor for decoding the multimedia data files, wherein:

the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and

the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus;

wherein:

after one of the different virtual data carriers is selected, the processor displays the selected one of the different virtual data carriers on the display for a first predefined time,

after the first predefined time, the processor displays a first one of the different titles of the selected one of the different virtual data carriers on the display, and

the processor, in accordance with an operation of the loudspeaker, plays back the multimedia data file corresponding to the first one of the different titles.

6. (Previously Presented) The device according to claim 17, further comprising:

a disk drive for the storage device, wherein:

the storage device is removable from the disk drive.

7. (Previously Presented) The device according to claim 6, wherein after the storage device is inserted into the disk drive, the processor:

automatically decodes a first one of the multimedia data files having a first one of the different titles in a first one of the different virtual data carriers, and plays back through the loudspeaker.

8. (Previously Presented) The device according to claim 17, wherein:

the processor extracts information from respective ones of the multimedia data files, and
the processor provides the extracted information to the display.

9. (Previously Presented) A device for playing back multimedia data files stored in an automotive sound system, comprising:

a display;
a loudspeaker for performing a playback of the multimedia data files;
an input apparatus;
a storage device; and
a processor for decoding the multimedia data files, wherein:
the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus;
wherein:

the processor extracts information from respective ones of the multimedia data files,
the processor provides the extracted information to the display;
when a respective one of the multimedia data files does not store a corresponding one of the different titles, the processor displays one of a name of the respective one of the multimedia data file and a number as a title on the display.

10. (Previously Presented) The device according to claim 17, wherein:

after an input signal is provided by the input apparatus, the processor

plays back the multimedia data files of one of the different virtual data carriers in a random sequence.

11. (Previously Presented) The device according to claim 17, wherein:
after an input signal is provided by the input apparatus, the processor plays back all the multimedia data files of the storage device in a random sequence.
12. (Previously Presented) The device according to claim 17, wherein:
after an input signal is provided by the input apparatus, the processor begins to play the multimedia data files of one of the different virtual data carriers and of the entire storage device.
13. (Previously Presented) The device according to claim 17, wherein:
the storage device includes one of a CD ROM, a DVD, a minidisk, a chip card, and a hard disk.
14. (Previously Presented) The device according to claim 17, wherein:
the multimedia data files are coded in MP3.
15. (Previously Presented) The device according to claim 17, wherein:
the input apparatus includes a remote control apparatus.
16. (Previously Presented) The device according to claim 17, wherein:
the processor displays information step-by-step on the display.
17. (Previously Presented) A device for playing back multimedia data files stored in an automotive sound system, comprising:
a display;
a loudspeaker for performing a playback of the multimedia data files;
an input apparatus;
a storage device; and
a processor for decoding the multimedia data files, wherein:

U.S. Pat. App. Ser. No. 09/816,526
Attorney Docket No. 10191/1773
Supplemental/Replacement Appeal Brief

the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers, and the multimedia data files as different titles on the display, and the different virtual data carriers and the different titles are selectable in accordance with an operation of the input apparatus.

U.S. Pat. App. Ser. No. 09/816,526
Attorney Docket No. 10191/1773
Supplemental/Replacement Appeal Brief

EVIDENCE APPENDIX

Appellants have not submitted any evidence pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132, and do not rely upon evidence entered by the Examiner.

U.S. Pat. App. Ser. No. 10/137,091
Attorney Docket No. 10191/2423
Replacement/Substitute Appeal Brief

RELATED PROCEEDINGS INDEX

There are no interferences or other appeals related to the present application.